

### REMARKS

This paper is in response to the final official action dated February 23, 2004 (hereafter, the "official action"). This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the first month and authorization to charge the requisite extension fee to our deposit account.

Claims 1-8, 11, 13-16 and 19-24 are pending in the application. Claims 11 and 13-15 have been allowed, and claims 5, 22, and 24 have been objected to, but are allowable in substance. Claims 1-4, 6-8, 16, 19-21, and 23 therefore remain at issue.

Claims 1-4, 6-8, 16, 19-21, and 23 have been rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-25 of U.S. Patent No. 6,079,339 to Houk Jr. *et al.* ("the '339 patent") in view of U.S. Patent No. 4,843,975 to Welsh *et al.* ("the '975 patent").

The single basis for rejecting the claims is addressed herein. Reconsideration of the application, in view of the following remarks, is respectfully requested.

### CLAIM REJECTIONS

Applicants respectfully traverse the rejections of claims 1-4, 6-8, 16, 19-21, and 23 for obviousness-type double patenting over claims 1-25 of the '339 patent in view of the '975 patent.

Obviousness-type double patenting requires the rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a non-prior art, commonly owned patent or patent application. The analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection. *See* M.P.E.P. §804 B.1.

A *prima facie* case of obviousness *requires* three basic criteria. *First*, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. *Second*, there must be a reasonable expectation of success in doing so. *Third*, prior art references, when combined, must teach or suggest all of the claim limitations. *See* M.P.E.P. §2142.

At least the first and third criteria have not been satisfied with respect to all pending claims 1-4, 6-8, 16, 19-21, and 23, as explained in more detail below. In

view of these deficiencies, the applicant respectfully submits that the obviousness-type double patenting rejections of claims 1-4, 6-8, 16, 19-21, and 23 should be withdrawn.

*I. Claims 1-4 and 6-8*

The proposed combination of the '339 patent and '975 patent does not disclose or suggest a shelving system comprising at least one inner support structure having a curved configuration resulting in a non-continuous height over the length of the panel and at least one outer support structure having a continuous height over the length of the panel, as recited by independent claim 1 and dependent claims 2-4 and 6-8.

The examiner acknowledged that the '339 patent does not disclose "support structures having a constant height across the length of the panel," as recited by claim 1. *See* official action at page 3. The '339 patent also does not suggest support structures having a constant height across the length of the panel because it emphasizes various advantages of the disclosed *curvilinear rails*. *See*, for example, the '339 patent at column 3, lines 5-7 and at column 5, lines 53-61. Accordingly, the '339 patent does not disclose or suggest *the combination* of at least one outer support structure having a continuous height over the length of the panel with at least one inner support structure having a curved configuration resulting in a non-continuous height over the length of the panel, as recited by claims 1-4 and 6-8.

Because the '339 patent does not disclose or suggest support structures having a constant height across the length of the panel, the examiner turned to the '975 patent. The '975 patent discloses a shelf comprising rib sections 22. Rib sections 22, however, do *not* have a continuous height *over the length of the shelf*, as the examiner has asserted. Rather, each rib section 22 is divided into two separate segments by a channel 26. *See*, for example, Figure 2 of the '975 patent. The '975 patent discloses that "channels 26 are positioned so that additional air circulation is provided for any items on shelf 12 and also provide space for a moderate amount of liquid which may drain from the stored items." Thus, based on the importance of including such channels, it is respectfully submitted that the '975 patent does not disclose or suggest support structures having a constant height across the length of the panel, as recited by claims 1-4 and 6-8.

Moreover, notwithstanding its lack of disclosure regarding support structures having a constant height across the length of the panel, the '975 patent does not provide any *motivation* for combining at least one support structure having a constant height across the length of the panel with at least one inner support structure having a curved configuration resulting in a non-continuous height over the length of the panel, as recited by claims 1-4 and 6-8. Additionally, the examiner's stated reason for combining these disclosures (i.e., reducing the amount of tooling required to manufacture the panel (*see* official action at page 3)) is not applicable as the amount of tooling required for manufacturing the panels disclosed in the '339 patent and those in accordance with claims 1-4 and 6-8 would generally be the same. Further, the stated motivation is not found within either of the cited disclosures. Accordingly, the proposed combination of the '339 and '975 patents is improper.

Therefore, the claimed subject matter of claims 1-4 and 6-8 is patentably distinct from the subject matter claimed in the '339 patent, even when its disclosure is combined with the '975 patent.

In view of the above analysis, the applicants respectfully request withdrawal of the obviousness-type double patenting rejection of claims 1-4 and 6-8.

## *II. Claims 11 and 13-15*

The examiner's indication that the above-referenced claims are allowable is acknowledged.

## *III. Claims 16, 19-21, and 23*

For reasons similar to those provided above with respect to claims 1-4 and 6-8, it is respectfully submitted that the proposed combination of the '339 and '975 patents does not disclose or suggest a shelving system comprising at least one panel, wherein each panel includes (1) a set of first support structures and (2) a second set of support structures, wherein the set of first support structures are box beams and the set of second support structures are Z-shaped beams, as recited by claims 16, 19-21, and 23. Panels incorporating a combination of such support structures exhibit unexpectedly improved structural integrity, and the '339 and '975 patents do not disclose or suggest combining different types of support structures as described above. Moreover, it is respectfully submitted that there is no motivation to combine these documents as described above.

Therefore, the claimed subject matter of claims 16, 19-21, and 23 is patentably distinct from the subject matter claimed in the '339 patent. In view of the above observations, the applicants respectfully request that the obviousness-type double patenting rejection of claims 16, 19-21, and 23 be withdrawn.

*IV. Conclusion*

It is respectfully submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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